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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,259	03/07/2002	Chad Roberts	P1139.0011/P011	9265

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EXAMINER	
ORTIZ, BELIX M	

ART UNIT	PAPER NUMBER
2175	8

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,259	ROBERTS ET AL.	
	Examiner	Art Unit	
	Belix M. Ortiz	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-19 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3,7.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of the following informalities:

   Abstract contains less than 50 words. Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

   The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

   The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchelmore (U.S. publication 2002/0090934).

As to claim 1, Mitchelmore teaches a mechanism for configuring handheld devices (see paragraph 100), comprising:

a website engine, for receiving user input (see paragraph 85);

a build-to-order configuration engine; for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts (see paragraphs 8, 18, and 65);

a database engine, for managing executable code and data responsive to the configuration engine (see paragraphs 66 and 103), and

a loading station; for performing the actual downloads (see paragraphs 5 and 103);

wherein the loading station loads the handheld device based on user input received through the website engine and conveyed to the database and build-to-order configuration engines (see paragraphs 8, 18, 65, and 85).

As to claim 2, Mitchelmore teaches wherein the configuration engine communicates automatically with the developers using a registration module (see paragraphs 27, 86, and 90).

As to claim 3, Mitchelmore teaches wherein the registration module communicates with the developers using either pooled, generated, or dynamically requested communications (see paragraphs 19, 66, and 161).

As to claim 4, Mitchelmore teaches wherein the registration module supports the random-key method of software registration (see figure 8 and paragraph 111).

As to claim 5, Mitchelmore teaches wherein the registration module supports the device-ID method of software registration (see paragraphs 96 and 199, table 2).

As to claim 6, Mitchelmore teaches wherein the loading station further comprises a transfer component, which transfers data back and forth over a physical medium through a port, and an operating system driver layer, which handles the actual moving of the bits through the port over the physical medium (see figure 24 and paragraphs 30 and 131).

As to claim 7, Mitchelmore teaches wherein the transfer component is abstracted such that it sees differing connection types as the same, because the operating system driver layer is responsible for the actual moving of the bits (see paragraph 173).

As to claim 8, Mitchelmore teaches wherein software drivers of the connection types can be added to or removed from the loading station (see paragraphs 92, 106, and 108).

As to claim 9, Mitchelmore teaches wherein software drivers of the connection types are extended from sample software modules obtained from product developers (see paragraphs 18 and 157).

As to claim 10, Mitchelmore teaches wherein the build-to-order configuration engine contains links of which handheld applications cannot coexist with each other or are incompatible with specific handheld hardware (see paragraphs 59, 171, and 184).

As to claim 11, Mitchelmore teaches wherein the build-to-order configuration engine receives data from the handheld device itself through the communication port of the loading station (see paragraphs 8, 18, 65, and 85).

As to claim 12, Mitchelmore teaches wherein the build-to-order database further comprises a database catalog which contains information about a plurality of handheld software products, including what Operating System (O/S) version that product may require, the memory consumption of that product, what other software applications the product may be dependant upon, and any other

products/applications that it conflicts with (see paragraphs 15-17, 125, 126, and 131).

As to claim 13, Mitchelmore teaches wherein the build-to-order database further comprises a database catalog which contains information about a plurality of handheld software products, including what Operating System (O/S) version that product may require, the memory consumption of that product, what other software applications the product may be dependant upon, and any other products/applications that it conflicts with (see paragraphs 15-17, 125, 126, and 131).

As to claim 14, Mitchelmore teaches wherein the database engine comprises a database catalog which contains handheld software pricing and supplier information, lead time, descriptions, sales volume levels, product shots (images), and geographic sales restrictions, all of which is obtained from the developers of the software (see figure 20 and paragraph 52).

As to claim 15, Mitchelmore teaches wherein the database engine further comprises a dependency checker- portion for comparing parameters related to each piece of software (see paragraphs 124 and 125).

As to claim 16, Mitchelmore teaches wherein the build-to-order configuration engine further comprises a plurality of registration code mechanisms each supported by a specialized registration module (see paragraphs 19, 27, 66, 86, 90, and 161).

As to claim 17, Mitchelmore teaches wherein the build-to-order configuration engine further comprises a plurality of registration code mechanisms which can complete the registration process even when all software is preloaded on the handheld device (see figures 29 and 30).

As to claim 18, Mitchelmore teaches wherein a customer sends an existing handheld device to a location having a build=to-order configuration engine, a database engine, and a loading station, wherein the customer accomplishes all download registrations without using the website engine (see paragraph 109).

As to claim 19, Mitchelmore teaches a method of loading software onto a handheld device (see paragraph 3), comprising:

querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate the software, that the desired software has no conflicts with any other software desired by the user, and that the handheld

device O/S (Operating System) can accommodate the software (see paragraph 5);

querying the handheld device to ensure sufficient memory is available, and reporting an error back to the user if necessary (see paragraphs 100 and 182);

if necessary, prompting a user to order additional memory such as on a memory card; and locating the software program on the memory card where possible (it will by obvious to have a memory card to load software if the memory of the handheld is full).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 703-305-7605, and after October 18, 2004 my new telephone number is going to be (571)-272-4081. The examiner can normally be reached on moday-friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bmo

September 17, 2004.

SAM RIMELL
PRIMARY EXAMINER